UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/316,795	05/21/1999	RONALD P. SANSONE	E-846	8309

919 7590 01/12/2005

PITNEY BOWES INC.
35 WATERVIEW DRIVE
P.O. BOX 3000
MSC 26-22
SHELTON, CT 06484-8000

EXAMINER	
BELL, PAUL A	

ART UNIT	PAPER NUMBER
3628	

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/316,795	SANSONE ET AL.	
	Examiner	Art Unit	
	PAUL A BELL	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10/15/2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 6-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 6-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 10 and 11 of U.S. Patent No. 6,549,892. Although the conflicting claims are not identical, they are not patentably distinct from each other because;

the applicant Sansone et al. in present application 09/316,795 teaches in claim 1 ;

A method for **forwarding mail** by a post that is addressed to a recipient at a virtual post office box to be delivered directly to a recipient without the recipient going to the host, said method comprises the **steps of**:

(a) receiving recipient's name and recipient's **desired** delivery address,

(b) assigning **a virtual post office box identification** for individual recipients,

(c) relating recipient's virtual post office box with the desired delivery address of the recipients,

(d) delivering to recipients their assigned virtual post office box's identification,

(e) placing virtual post office boxes on mail,

(f) reading mail to capture virtual post office box identification, when present,

(g) determining recipient's desired delivery address from **virtual post office box identification and recipient's name,** determining in one or more **data bases** that recipient's name is listed with recipient's desired delivery address and is the address to which the owner of the virtual Post office box wants the mail forwarded,

(h) wherein the forwarding information may be sent by telephone, physical mail or facsimile,

(i) placing recipient's **desired** delivery address on mail **in coded form and human readable form**;

(j) and delivering mail to the **desired** delivery address of the recipients.

And since Sansone in Patent (6, 549,892) in claims 1, 10 and 11 also teaches;

(CLAIM 1)

A method for **delivering mail** that is addressed to a named recipient, said method comprises the steps of:

(a) receiving recipient's name and recipient's **current** delivery address,

(b) assigning **a unique code** for individual recipients,

(c) relating in a database recipient's unique code with recipient's name and **current** delivery address,

(d) delivering information to recipient's that represents their assigned unique codes,

(e) placing by the sender of mail information that represents recipient's name and unique code on mail,

(f) reading information on mail to capture recipients name and unique code, when present,

(h) **changing recipient's current delivery address** in the data base in accordance with recipient's instructions,

(g) determining recipient's current delivery address from recipients **name and unique code,**

(part of i) printing by a mail carrier on mail recipient's current delivery address if the current delivery address on the mail differs from the recipient's delivery address currently in the data base,

(j) and delivering mail to recipient's **current** delivery address.

(CLAIM 10)

(part of I) The method claimed in claim 1, wherein recipient's current delivery address is placed on mail in coded form.

(CLAIM 11)

(part of I)The method claimed in claim 10, wherein recipient's current delivery address is placed on mail in human-readable form.

Wherein it is obvious that the patent, "**current** delivery address" would have been the applications "**desired** delivery address" and further the patents "**a unique code**" is an obvious functional equivalent to the applications **"a virtual post office box identification".** Note the steps in the patent claim and application have been lettered and key phrase highlighted for illustrative purposes only in an effort to illustrate the one to one correspondence of the steps which are obvious equivalents.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1 and 6-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boies et al. (6,006,200) in view of Moore (5,452,203), Whitehouse (6,005,945) and Allum et al. (5,420,403).

With regard to claim 1 Boies et al. teaches a method for forwarding mail by a post that is addressed to a recipient at a virtual post office box to be delivered directly to a recipient without the recipient going to the post (SEE Boies et al. figure 1 and abstract), said method comprises the steps of: receiving recipient's name and recipient's desired delivery address (SEE Boies et al. figure 2A, item 203 "COLLECT MAILING ADDRESS INFORMATION") assigning a virtual post office box identification for individual recipients (SEE Boies et al. figure 1 item 16 column 2, lines 14-16 "The personal identifier is a multi-digit numeric or alphanumeric code assigned to a customer), relating recipient's virtual post office box with the desired delivery address of the recipients (SEE Boies et al. figure 1, item 10), delivering to recipients their assigned virtual post office box's identification (SEE Boies et al. column 2, lines 15-25 and see figure 2B item 209 "SEND IT BACK TO USER"), placing virtual post office boxes on mail (SEE Boies et al. figure 2C items 217 and 218), reading mail to capture virtual post office box identification, when present (SEE Boies et al. figure 1, items 10 and 14 and column 2, lines 18-22 and 60-64), determining recipient's desired delivery address from virtual post office box identification (SEE Boies et al. figure 1, items 10 and 14 and column 2, lines 18-22 and 60-64), determining in one or more data bases that recipient's name is listed with recipient's desired delivery address and is the address to which the owner of the virtual Post office box wants the mail forwarded, wherein the forwarding information may be sent by telephone physical mail or facsimile (SEE Boies et al. these features are illustrated in more detail in figures 2A, 2B and 2C), and delivering mail to the desired delivery address of the recipients (SEE Boies et al. column 2, lines 60-64).

Boies et al. does not illustrate placing recipient's desired delivery address on mail in coded form and human readable form. Boies et al. instead illustrates in figure 1, item 10 the address in "human form" but in view of the highly automated sorting of mail as it travels across the county interfacing at multiple points it would have been logical to have put both machine form and readable form wherein the readable form is used during last mile by a human mail man.

Allum discloses the use of coded form, human readable form or both to print a delivery label (SEE Allum figures 7 and 8) to facilitate the routing of the mail automatically and to assist the delivery person to find the correct delivery address. Thus, it would have been obvious to one of ordinary skill in the art to modify the method of Boies et al. by adopting the teaching of Allum to facilitate the faster routing of the packages automatically and to assist a delivery person to find correct delivery addresses.

And further Boies et al. does not clearly illustrate using the, "recipient's name", when determining recipient's desired delivery address he instead clearly illustrates using a multi-digit identifier item 16 "(#71134U47B)" , however figure 1 does illustrate the title "CUSTOMER" clearly on a separate line above item 16 the multi-digit identifier and especially note it's in all capital letters . and in view of this it is reasonable to content that one of ordinary skill looking at Figure 1 would think the word "CUSTOMER" was suggestive of some "NAME" given by user along with his multi-digit identifier below it.

This obvious interpretation would be in step with the established conventional practice, for example it has been a common practice to put the NAME of the PERSON

or BUSINESS, GOV AGENCY above the post office box # when addressing letters. Another example would have been where most forms require both a legal NAME and a social security number or employee number for proper identification purposes. And still further it has been a common practice when logging into a computer or web site where one has an account to provide a USERNAME and a password, whereby the USERNAME was creatively selected by the user and this NAME would have been some form of his legal name or a chosen nick name keeping secret his real name.

This suggested interpretation or modification of the Boies et al. method would have been in step with the objective of the Boies al. invention for example column 3, lines 4-6 state, "The benefit for the customer is that a LEVEL of anonymity is established for the transaction." Clearly the Boies et al. objective of keeping his actual mail address off the direct marketing mailing lists would have been maintained (SEE Boies et al. column 1, lines 1-35). And still further two references are listed below to provide evidence to the well known statements made above.

Moore (5,452,203) illustrates "CORRECTING CUSTOMER ADDRESS" (SEE title) and teaches the well known practice of putting the NAME of the PERSON or BUSINESS, GOV AGENCY above the post office box # when addressing letters (SEE Moore column 1, lines 57-59 "Pitney Bowes, Inc., Box 3000").

Whitehouse (6,005,945) illustrates "DISPENSING POSTAGE" (SEE title) and teaches the well known practice of providing at least two fields of information for proper identification and error checking of the user such as USERNAME and Password. (SEE Whitehouse column 12, lines 57-65 "The central computer, after decrypting the request

message, validates the postal indicium request by verifying the digital signature, if any, in the request, and validating the meter or account ID and account password in the request message (step 202, by validation procedure 161). If the meter/account ID does not correspond to an active postage dispensing account, or if the password is incorrect, an error message is returned to the request sender.").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to interpret or modify the Boies et al. to clearly use the "NAME feature", because Boies et al. as stated above provided suggestion and further irregardless, the analysis prior mail art of Moore and Whitehouse also suggested it wherein they simply teach it is was a well known practice use a NAME with the identification number and still further as additional added motivation Whitehouse provided a means for error checking which would have been used by Boies et al.

With regard to claim 6 the combination of Boies et al., Moore, Whitehouse, and Allum et al. teaches the method claimed in claim 1, further including the step of. changing recipient's desired delivery address in accordance with recipient's Instructions (SEE Boies et al. column 4, lines 12-15 "notifying by a customer a change").

With regard to claims 7 the combination of Boies et al., Moore, Whitehouse, and Allum et al. does not illustrate the method claimed in claim 6, "wherein in the changing step: recipient specifies the time period In which mail is going to be delivered to the desired delivery address". However, it is an old and well-known practice to specify the time period in which mail is going to be delivered to the changed delivery address (e.g., when someone is on vacation, it has been a common practice to notify the post

Office to reroute the mail to a next neighbor or hold until the person comes back from the vacation), and nothing unobvious is seen to have been involved in simply having employed this old well-known practice for the claimed method to facilitate efficient mail delivery.

With regard to claims 8, 9 and 10 the combination of Boies et al., Moore, Whitehouse, and Allum et al. does not illustrate the well-known details whereby the method claimed in claim 1, further including the step of: billing for the number of times recipient's changed their desired delivery address, metering the number of times recipient's desired delivery address was determined, and billing for the number of times recipient's desired delivery address was determined (however it was a fundamental practice of the service provider to charge when services are used and changed and at the end of the billing cycle providing a metering of these services in a billing statement as a means of making more money. Thus, it would have been within the level of ordinary skill in the art to employ this fundamental practice to the claimed method to increase the profit.

With regard to claim 11 the combination of Boies et al., Moore, Whitehouse, and Allum et al. teaches the method claimed in claim 1, wherein recipients virtual post office box is represented in alphanumeric characters (SEE Boies et al. column 2, lines 14-16).

With regard to claims 12 and 13 the combination of Boies et al., Moore, Whitehouse, and Allum et al. does not illustrate the well-known details whereby the method claimed in claim 1, further including the steps of: (a) assigning access codes to recipients that are related to recipient's virtual post office box, (b) delivering access

codes to recipients, (c) receiving recipient's name, access code and recipient's Intention to change their delivery address, and (d) changing recipient's delivery address upon conformation of recipient's name and access code and (e) confirming recipient's virtual post office box (However SEE Boies et al. column 4, lines 12-15 "notifying by a customer a change" wherein of course, to keep anonymity and privacy (see the abstract of Boies), the use of the claimed steps of a-e would have been obvious).

With regard to claim 14 the combination of Boies et al., Moore, Whitehouse, and Allum et al. does not illustrate the method claimed in claim 12, wherein in the changing step: recipient specifies the time period in which mail is going to be delivered to the changed delivery address (however SEE response to claim 7 above where this feature was covered).

With regard to claim 15 the combination of Boies et al., Moore, Whitehouse, and Allum et al. teaches the method claimed in claim 12, further including in the changing step, the steps of: (a) assigning a biometrics to recipients, (b) delivering the biometrics to recipients, (c) receiving recipient's biometrics and recipient's intention to change their delivery address, (d) changing recipient's delivery address upon conformation of recipient's biometrics, (However SEE Boies et al. column 4, lines 12-15 "notifying by a customer a change" wherein of course, to keep anonymity and privacy (see the abstract of Boies), the use of the claimed steps of a-d would have been obvious and within the level of ordinary skill in the art. More specifically, it would have been obvious to assign a biometrics such as for example a finger print to recipients that are related to each

recipient's virtual post office box to prevent others from accessing unauthorized post office boxes.

With regard to claims 16, 17, 18, 19, and 20 the combination of Boies et al., Moore, Whitehouse, and Allum et al. does not illustrate all of the standard conventional practices whereby the method claimed In claim 12, wherein recipient's name, access code and recipient's intention to change their delivery address will be received by telephone, facsimile, computer, in person, received by mail, (However SEE Boies et al. column 4, lines 12-15 "notifying by a customer a change" wherein those above methods of communications are all well-known methods as desired to notify the changes of the personal information to effect the change of the address and further the one you use is not critical to the practice of Boies et al. or applicant.).

With regard to claim 21 the combination of Boies et al., Moore, Whitehouse, and Allum et al. does not illustrate the method claimed in claim 12, wherein recipient's access code Is encrypted (however, it is a well-known practice in the art to encrypt any vital information in the art to prevent fraudulent access of personal account or database and it would have been common sense to employ this well-known practice for the claimed method to further enhance the anonymity and privacy (SEE the abstract of Boies) of the recipient.

5. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Boies et al., Moore, Whitehouse, and Allum et al. as applied to claim1 above, and further in view of Allen (US PAT 5,422,821).

With regard to claim 22 the combination of Boies et al., Moore, Whitehouse, and Allum et al. does not illustrate, "wherein one of the data bases is the National Name and Address Data Base".

However Allen teaches the use of the National Name and Address Data Base (i.e., US PS National Change of Address database) to identify, intercept and forward incorrectly addressed mail pieces (SEE Allen et al. column 2, lines 57-68).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination of Boies et al., Moore, Whitehouse, and Allum et al. because he teaches how to identify, intercept and forward incorrectly addressed mail pieces.

Response to Arguments

6. Applicant's arguments with respect to claims 1 and 6-22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

"SIEMENS WINS US POST OFFICE CONTRACT", European Report Brussels: **Oct 7, 1998** . Discloses that a New Delivery Bar Code Sorter DBCS and a new computer and LAN technology for handling address correction and a **mail Forwarding** Control System was developed by Siemens. At the time this contract was awarded this product as perceived by the Post Office likely represented the then current state of a system in production with regards to forwarding of mail. This short news article lacks any necessary details of how this Siemens method of "mail forwarding" works and therefore the examiner was not able to consider those missing details with regards to the actual system sold to US Post Office .

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Bell whose telephone number is (703) 306-3019.

Information regarding the status of an application may be obtained from Patent Application Information Retrieval (PAIR) system, see http://pair-direct.uspto.gov. For help with PAIR call Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or Faxed to: (703) 872-9306

Paul Bell
Art unit 3628
January 10, 2005

HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600